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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/998,302	12/24/1997	JOEL D. STANFIELD	STE01-P798B	2417

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PRICE HENEVELD COOPER DEWITT & LITTON
P O BOX 2567
695 KENMOOR DRIVE S E
GRAND RAPIDS, MI 49501

EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT

PAPER NUMBER

2635

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/998,302	Applicant(s) STANFIELD ET AL.	
	Examiner Brian A Zimmerman	Art Unit 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Applicant's Brief filed 3/15/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Status of Application.

In response to the applicant's arguments filed in the brief received on 3/15/02. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-63 are unpatentable for the reasons set forth in this office action:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

1. Claims 1-6,11-14,16,18,38-41,63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5455409) and Kott (4376936).

Smith shows a file tracking system in which a processor is connected to a bus that is connected to a folder retainer 12. The processor gets requests from an input device (col. 5 line 55 to col. 6 line 10) and sends information to a folder such that an indicator displays the location of the folder to a user requesting to know the location of the folder. Smith discloses that the use of a database for maintaining location information is an alternative to the distributed database system. It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. Smith uses polling to determine the location of the files. See abstract. From this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

In an analogous art, Kott shows a file folder that is placed in a file retainer and is polled by a processor in the retainer via a shared conductive bus. The file includes conductors on the file folder configured to couple the folder to a retainer. The folder responds to a polling signal to indicate its location. It is clear that Kott shows a file with a conductor located on the surface of the file. Kott also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Kott's folder has the contacts on the side and edge of the surface of the folder. Kott includes an indicator on the file. Kott shows the files could be located on a plurality of shelves (col. 4 line 29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Kott to store documents' information in a filing system which can communicate to the folders in the manner suggested by Kott since such would provide the cheap communication with the file.

The references above show the use of LEDs as indicators to assist in locating the file. The examiner takes official notice that activating an LED with a transistor, in the manner claimed, is common practice for driving LEDs.

2. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Kott as applied to claim 1 above, and further in view of Foster (5287414).

In an analogous art, Foster shows a file locating system that includes a PC 24 to record and display the location of the files. This provides assistance to the user in determining the location of a desired file. When the drawer is closed the codes are again input into the computer to update the location database. Col. 4 lines 19-26.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a PC for storing and displaying the location of a desired file, since such would assist the user in determining the location of a desired file.

3. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott and Foster as applied to claims 1 and 7 above, and further in view of Doyle (5426284).

In an analogous art, Doyle shows a file locating system that includes a computer (figure 2). The computer includes links 216 and 220 for communicating to other computers. The examiner takes official notice that the use of a LAN to connect computers is very common in the art of computer networks, and as such would have been verily obvious to one of ordinary skill at the time of the invention.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott as applied to claims 1 and 12 above, and further in view of the Dallas Semiconductor publication "Touch the Future."

The article shows the use of trays for holding objects that are to be located. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a tray for holding and communicating with files in the manner suggested by the above modified system since such would provide increased locating abilities.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott as applied to claims 1 and 12 above, and further in view of Leighton (3701987).

Leighton shows the positioning of the communication rails on the bottom of the file drawer. See figure 4. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized communication rails on the bottom of the drawer of the above modified system to provide an equivalent communication to the files.

6. Claims 19-45,47-60,62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5455409) and Kott (4376936) and Wakura (5063380).

Smith shows a file tracking system in which a processor is connected to a bus that is connected to a folder retainer 12. The processor gets requests from an input device (col. 5 line 55 to col. 6 line 10) and sends information to a folder such that a indicator displays the location of the folder to a user requesting to know the location of the folder. Smith discloses that the use of a database to maintain the location information is an alternative to the distributed database system. It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. Smith uses a polling request to determine the query the location of the files. See abstract. From this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

In an analogous art, Kott shows a file folder that is placed in a file retainer and communicates with the retainer via a common conductive bus. The file includes conductors on the file folder configured to couple the folder to a retainer. The folder responds to a polling signal to indicate its location. It is clear that Kott shows a file with a conductor located on the surface of the file. Kott also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Kott's folder has the contacts on the side and edge of the surface of the folder. Kott includes an indicator on the file. Kott shows the files could be located on a plurality of shelves (col. 4 line 29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Kott to store documents information in a filing system which can communicate to the folders in the manner suggested by Kott since such would provide the cheap communication with the file.

In an analogous art, Wakura shows a file locating system that includes a central computer that sends request to locate files to cabinets 10 (figure 4). Each cabinet is in communication with the files it is currently storing, and has a display on the computer and the cabinet to assist the user in finding the located file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the distributed scheme suggested by Wakura in the above modified system in order to assist the user in finding the located file.

7. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott, and Wakura as applied to claim 43 above, and further in view of Warren (5398919).

In an analogous art, Warren teaches the use of a permission list to authorize the user to access the located file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a permission list to authorize the user to use the above modified system since such would increase security.

8. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott, and Wakura as applied to claims 1 and 12 above, and further in view of the Dallas Semiconductor publication "Touch the Future."

The article shows the use of trays for holding objects that are to be located. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a tray for holding and communicating with files in the manner suggested by the above modified system since such would provide increased locating abilities.

9. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott and Wakura as applied to claim 54 above, and further in view of either Caswell (4636950).

In an analogous art, Caswell shows a inventory locating system where the object to be located is coupled to the processor by an RF link. This eliminates the need for

specialized connectors to provide communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized an RF link to actively communicate between the object to be located and the processor in order to simplify the mechanics of the communication system.

Response to Arguments

Applicant's arguments filed 7/18/01 have been fully considered but they are not persuasive.

a) The applicant argues that Kott does not disclose that the devices on each docket card folder can send reply signals back to the control circuit. Further, the applicant argues that Kott does not maintain any form of database including the identification codes of the docket cards contained within the docket card box.

The examiner submits that Kott is not cited for teaching reply signal or maintaining a database. It is clear from the rejection that Smith is cited for teaching such elements.

b) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, clear motivation is given in the above rejections. MPEP 2144 explains the sources of rationale supporting a rejection Under 35 U.S.C. 103

RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART-RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

c) The applicant argues that using Smith to track folders is not practical. The examiner points out that practicality is not an issue when considering obviousness combination rejections. Smith clearly shows that the tracking system can be used to

locate or manage books, tapes, cassettes and the like, it is the examiner's position that file folders are well within the intent of such a disclosure.

d) The applicant argues that Smith does not send a polling signal with a unique address to the folder. Smith does send a unique signal to the cassette requesting information. Additionally, Kott teaches a shared bus for communicating a polling signal. This shared bus reduces wiring costs and requires that each communication to the folder include a unique identifier.

e) The applicant argues that Kott does not suggest a folder responsive to a control signal including a unique address to transmit a signal back to the processor. Kott is responsive to a control signal that includes a unique address. Col. 2 lines 49-56. Smith on the other hand discloses a system that includes a folder (cassette) that responds to a command by sending data back to the processor for maintaining a central database that assists users in locating folders.

f) The applicant argues that because Kott does not send a reply signal, it would ruin Smith's ability to locate a folder (if the two were combined). If the applicant's reasoning were followed, there could never be a 103-obviousness rejection. If an element were lacking from one reference, adding a reference to teach the obviousness of such an element would ruin the reference that lacks it. This reasoning is not persuasive. Kott teaches a common bus communication method for communicating to

folders using a unique identification. Smith suggests that reply messages can be used for database maintenance. Both have something to offer one of ordinary skill in constructing a folder management system.

g) Regarding claim 38, the applicant points out that in some respects claim 38 is broader than claim 1 in that claim 38 does not require a bus or database. However the applicant argues that the references do not teach a conductor coupled to the folder contacts at a plurality of locations on the file folder. The three contacts on the bus provide a plurality of locations for the conductor (communication bus) to contact the folder.

h) Regarding claim 3, the applicant argues that the references do not teach a system where an operator inputs a command to search for a specific file. It is noted that Smith teaches an operator input (keyboard figure 8a) to initiate the search for a file which the displayed to the operator via display 66.

i) Regarding claim 7, the applicant argues that the references do not teach polling the folders periodically to determine if any of the locations have changed. Foster teaches that when the drawer is closed the codes are again input into the computer to update the location database. Col. 4 lines 19-26. Therefore, periodically the locations are determined in order to update the database. In combination with the above polling location system Foster's suggestion makes the claimed limitation obvious.

j) Regarding claim 15, the applicant argues that the "Touch the Future" publication does not shows conductors positioned in the tray for making contact with the folder. In view of Kott's suggestions on col. 4 lines 28-33, such conductors to communicate would be within the skill of the ordinary artisan.

Regarding claim 17, the applicant argues that putting the conductors on the bottom of the file drawer would ruin the operation of Kott. First the examiner notes that shifting the location it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

k) Regarding claim 19, the applicant argues that the references do not teach the processor communicating signals that identify the storage location and then identify the file. First it is noted that the applicant's previous remarks, regarding the restrictions, have essentially admitted that the invention of claim 19 is not patentably distinct from that of claim 1. Smith suggests sending a signal directly to the object (folder) that inherently uniquely identifies the folder and the cabinet where the folder is located.

Communicating all this information on a common bus as suggested by Kott and Wakura would require the identity of the cabinet be spelled when all the cabinets share the same communication channel.

l) Regarding claim 20, the applicant argues that the references do not teach cabinets including drawers with their own indicator light to further narrow the location information. This is natural follow through on the Kott and Wakura concepts. Kott teaches cabinets with shelving (col. 4 lines 28-34), and Wakura teaches cabinets with shelf indicators (figure 7).

m) Regarding claim 23, the applicant argues that the references (Smith in particular) do not show sending an identifying signal to the cabinet. As discussed above with regards to claim 19, Smith suggests sending a signal directly to the object (folder) that inherently uniquely identifies the folder and the cabinet where the folder is located. Communicating all this information on a common bus as suggested by Kott and Wakura would require the identity of the cabinet be spelled when all the cabinets share the same communication channel.

n) Regarding claim 28, the applicant argues that Smith does not include a central database. As discussed previously regarding claim 1, Smith suggests the use of a central database for storing such information. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning,

it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

o) Regarding claim 30, the applicant argues that Smith does not show a common communication bus for communicating to all folders in the cabinet. While this may be true, Smith was not cited for teaching such a limitation. Kott shows a system that uses a common communication bus for communicating to all folders in the cabinet.


p) Regarding claims 34-41, the applicant argues that the references do not include a conductor location on the folder to couple the folder to the contacts of the cabinet when the folder is positioned in each of several different positions. Kott teaches the folder having contacts 115 that couples the folder to the contacts of the cabinet when the folder is positioned in the front of the cabinet or the rear of the cabinet.

q) Regarding claim 43, the applicant argues that the references cited do not teach maintaining general file information in a central database. Smith suggests a database or index storing information that can be searched using a library. See col. 1 lines 15-50.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 703-305-4796. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



Brian A Zimmerman
Primary Examiner
Art Unit 2635

BaZ
May 13, 2002